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10/657,588	09/08/2003	Andrea C. Hughs-Baird	0112300-1410	9903
29159	7590	06/29/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			SKAARUP, JASON M	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/657,588

Applicant(s)

HUGHS-BAIRD ET AL.

Examiner

Jason Skaarup

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/11/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The Examiner considered the Information Disclosure Statement (IDS) submitted on December 11, 2003.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation "wherein the display device is adapted to display a plurality of selections, and at least one of the plurality of award values are associated with the selections" as recited in claims 4, 16 and 29 must be shown or the feature(s) canceled from the claims. No new matter should be entered. Figure 14 shows the display device displaying a plurality of selections, wherein at least one of the plurality of modifier values is associated with the selections. However, Figure 14 or any other Figure does not show the display device displaying a plurality of selections, wherein at least one of the plurality of award values is associated with the selections.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 1, 13 and 24 are objected to because of the following informalities:

Claims 1 and 13 each recite the limitation "a plurality of the characteristics" in line 8 thereof. There is no antecedent basis for the term "the characteristics" as recited in claims 1 and 13. The Examiner believes that the limitation "a plurality of characteristics" would be a suitable replacement. Appropriate correction is required.

Claim 24 recites the limitation "one of each of the pairs of the characteristics each associated with one of the first outcomes" in lines 10-11 thereof. Claim 24 also recites the limitation "one of each of the pairs of the characteristics each associated with one of the second outcomes" in lines 12-13 thereof. The Examiner deems these limitations to be unclear. Specifically, the Examiner cannot determine whether one characteristic of each pair of characteristics is associated with one of the first outcomes (or second outcomes) or whether each pair of characteristics is associated with one of

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the first outcome (or second outcomes). In accordance with the Examiner's understanding of Applicant's intention, the Examiner suggests amending the above limitations to recite "a first characteristic of each pair of the same or related characteristics being associated with one of the first outcomes" and "a second characteristic of each pair of the same or related characteristics being associated with one of the second outcomes," respectively. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (U.S. Patent No. 6,692,355) in view of Webb (U.S. Patent No. 6,336,860).

Baerlocher et al. teach a gaming device as recited in claims 1, 13 and 24. The gaming device taught by Baerlocher et al. comprises:

a game operable upon a wager (gaming device 10 of Figure 1 along with the related description thereof);

a display device (value display 36 and modifier display 38 of Figure 1 along with the related description thereof);

a plurality of award values (or first values or first outcomes) adapted to be displayed by the display device (award values "5", "10", "20", "30" are displayed by award display 36 of Figure 1 along with the related description thereof);

a plurality of modifier values (or second values or second outcomes) adapted to be displayed by the display device (modifier values "1", "2", "3", "4" are displayed by modifier display 38 of Figure 1 along with the related description thereof); and

an award adapted to be provided to the player based on at least one generated award value and at least one generated modifier value (col. 6, lines 7-10 wherein an offer is the value multiplied by the player and the offer would constitute an award based on the award value and the modifier value when accepted by a player as shown in step 106 of Figure 3 along with the related description thereof).

Baerlocher et al. does not teach a gaming device that comprises a plurality of characteristics including at least two of the same or related characteristics, wherein (a) at least one of the characteristics is associated with at least one of the award values and is adapted to be displayed by the display device in association with the award value; (b) at least one of the characteristics is associated with at least one of the modifier values and is adapted to be displayed by the display device in association with the modifier value; and (c) an additional award is adapted to be provided to the player if the generated award value and the generated modifier value include the same or related characteristics. In a related gaming device, Webb teaches game symbols having a first defining criteria (in the form of value, number, rank or another visual representation) and a second defining criteria (in the form of color or shape). See col.

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7, line 65 to col. 8, line 2. Webb further teaches that the second defining criteria of the game symbols can be used to provide a player with an additional award when the second defining criteria of two or more game symbols is the same irrespective of the first defining criteria. See col. 6, lines 50-65. Webb teaches that awarding players additional awards based on matching the second defining criteria of game symbols, in addition to or in replacement of, the first defining criteria of game symbols provides the game operator the ability to offer a wide selection of games while enabling a player to play different games with varying payoffs and game volatility. See col. 8, lines 36-40. It would have been obvious for one skilled in the art at the time of the invention to incorporate the second defining criteria (in the form of color or shape) into the game symbols (award values and modifier values) of the gaming device taught by Baerlocher et al. in order to provide the game operator with the ability to offer a wide selection of games while enabling a player to play different games with varying payoffs and game volatility as desirably taught by Webb in col. 8, lines 36-40. Thus, the combination of Baerlocher et al. and Webb teaches a gaming device in which at least one characteristic (second defining criteria of Webb) is displayed in association with the game symbols (at least one of the award values and at least one of the modifier values of Baerlocher et al.), wherein an additional award is provided to the player if the game symbols (the generated award value and the generated modifier value of Baerlocher et al.) include the same or related characteristics (second defining criteria of Webb).

Regarding claims 2 and 14, the combination of Baerlocher et al. and Webb teaches displaying one of the plurality of award values or one of the plurality of modifier

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values on a wheel (Figure 4 of Baerlocher et al. along with the related description thereof).

Regarding claims 3 and 15, the combination of Baerlocher et al. and Webb teaches displaying one of the plurality of award values or one of the plurality of modifier values on a wheel (Figure 4). However, the combination of Baerlocher et al. and Webb does not explicitly teach displaying the award values on a first wheel and displaying the modifier values on a second wheel being concentrically arranged with the first wheel. It would have been an obvious matter of design choice to modify Baerlocher et al. to concentrically arrange wheels 36, 38 on the gaming device 10 since Applicant has not disclosed that having concentrically arranged wheels solves any stated problem or is for any particular purpose and it appears that wheels 36, 38 would perform equally well with wheels 36, 38 being separated on the gaming device 10.

Regarding claims 4 and 16, the combination of Baerlocher et al. and Webb teaches displaying a plurality of selections wherein one of the award values or one of the modifier values are associated with the selections (Figure 1 of Baerlocher et al. along with the related description thereof and col. 5, lines 42-53, wherein touch screen 25 is employed for displays 36, 38 to allow player selection of an award value "5", "10", "20", "30" or a modifier value "1", "2", "3", "4")

Regarding claims 5 and 17, the combination of Baerlocher et al. and Webb teaches that the displayed selections are player selectable (Figure 1 of Baerlocher et al. along with the related description thereof and col. 5, lines 42-53, wherein touch screen

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25 is employed for displays 36, 38 to allow player selection of an award value "5", "10", "20", "30" or a modifier value "1", "2", "3", "4").

Regarding claims 6 and 18, the combination of Baerlocher et al. and Webb teaches at least one different characteristic is associated with at least one of the award values and at least one different characteristic is associated with at least one of the modifier values (Figure 3 of Webb along with the related description thereof, wherein different characteristics, in the form of colors or shapes, is associated with each game symbol).

Regarding claims 7, 8, 9, 19, 20 and 21, the combination of Baerlocher et al. and Webb teaches that one of the characteristics is associated with each of the award values and that one of the characteristics is associated with each of the modifier values (Figure 3 of Webb along with the related description thereof, wherein one of the characteristics, in the form of colors or shapes, is associated with each game symbol).

Regarding claim 10, the combination of Baerlocher et al. and Webb teaches that the modifier values each include a multiplier value (Figure 1 of Baerlocher et al. along with the related description thereof, wherein modifier value display 38 displays multiplier values "1", "2", "3", "4")

Regarding claims 11 and 22, the combination of Baerlocher et al. and Webb teaches input devices which enable the player to accept or reject the award (input device 42 of Baerlocher et al. enable the player to accept an offer, wherein accepting the offer by the player constitutes acceptance of an award and input devices 44, 46 enable the player to reject the offer, wherein changing of the offer by the player

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constitutes rejection of an award). Also see col. 7, lines 7-18 of Webb, wherein a player may accept an award or reject the award for a secondary play.

Regarding claims 12 and 23, the combination of Baerlocher et al. and Webb teaches the additional award includes at least one repeat of the determination of the award, at least one credit, an additional modifier, or at least one free game or spin (col. 6, lines 50-65 of Webb, wherein the additional award is a payout including at least one credit).

Regarding claim 25, the combination of Baerlocher et al. and Webb teaches an additional one of the characteristics which is generated, wherein the additional award is increased if the additional characteristic includes the same or related characteristic (col. 2, lines 66-67 and col. 7, line 65 to col. 8, line 12 and Figure 3 of Webb, wherein the additional award is a payout based on the same defining criteria in the form of shape, color and letter which can be increased for different winning combinations).

Regarding claim 26, the combination of Baerlocher et al. and Webb teaches a method of operating a gaming device having a game operable upon a wager (Figures 1 and 3 of Baerlocher et al. along with the related descriptions thereof and Figure 3 of Webb along with the related description thereof). The method as taught by the combination of Baerlocher et al. and Webb comprises:

displaying a plurality of first values (award values "5", "10", "20", "30" are displayed by award display 36 in Figure 1 of Baerlocher et al. along with the related description thereof);

displaying a plurality of second values adapted to be displayed by the display device (modifier values "1", "2", "3", "4" displayed by modifier display 38 in Figure 1 of Baerlocher et al. along with the related description thereof);

associating a characteristic with at least one of the first values (Figure 3 of Webb along with the related description thereof, wherein one characteristic, in the form of color or shape, is associated with each game symbol);

associating a characteristic with at least one of the second values (Figure 3 of Webb along with the related description thereof, wherein one characteristic, in the form of color or shape, is associated with each game symbol);

displaying an indication of one of the first values (value display 36 in Figure 1 of Baerlocher et al. along with the related description thereof);

displaying an indication of one of the second values (modifier display 38 in Figure 1 of Baerlocher et al. along with the related description thereof);

providing the player an award based on the indicated first value and the indicated second value (col. 6, lines 7-10 of Baerlocher et al. wherein an offer is the value multiplied by the player and the offer would constitute an award based on the award value and the modifier value when accepted by a player as shown in step 106 of Figure 3 along with the related description thereof); and

providing the player an additional award if the indicated first value and the indicated second value include the same or related characteristics (col. 6, lines 50-65 of Webb, wherein if two game symbols have the same characteristic, in the form of color or shape, the player is provided an additional award).

Regarding claim 27, the combination of Baerlocher et al. and Webb teaches displaying one of the plurality of award values or one of the plurality of modifier values on a wheel (Figure 4 of Baerlocher et al. along with the related description thereof).

Regarding claim 28, the combination of Baerlocher et al. and Webb teaches displaying one of the plurality of award values or one of the plurality of modifier values on a wheel (Figure 4 of Baerlocher et al. along with the related description thereof). However, the combination of Baerlocher et al. and Webb does not explicitly teach displaying the award values on a first wheel and displaying the modifier values on a second wheel that is concentrically arranged with the first wheel. It would have been an obvious matter of design choice to modify Baerlocher et al. to concentrically arrange wheels 36, 38 on the gaming device 10 since Applicant has not disclosed that having concentrically arranged wheels solves any stated problem or is for any particular purpose and it appears that wheels 36, 38 would perform equally well in a concentric arrangement, a separate arrangement or any other arrangement on the gaming device 10.

Regarding claim 29, the combination of Baerlocher et al. and Webb teaches displaying a plurality of selections wherein one of the award values or one of the modifier values are associated with the selections (Figure 1 of Baerlocher et al. along with the related description thereof and col. 5, lines 42-53, wherein touch screen 25 is employed for displays 36, 38 to allow player selection of an award value "5", "10", "20", "30" or a modifier value "1", "2", "3", "4")

Regarding claim 30, the combination of Baerlocher et al. and Webb teaches enabling the player to select at least one of the selections to determine the award value or the modifier value (Figure 1 of Baerlocher et al. along with the related description thereof and col. 5, lines 42-53, wherein touch screen 25 is employed for displays 36, 38 to allow player selection of an award value "5", "10", "20", "30" or a modifier value "1", "2", "3", "4").

Regarding claim 31, the combination of Baerlocher et al. and Webb teaches displaying a characteristic associated with each award value and displaying a characteristic associated with each modifier value (Figure 3 of Webb along with the related description thereof, wherein characteristics, in the form of colors or shapes, can each be associated with different game symbols).

Regarding claim 32, the combination of Baerlocher et al. and Webb teaches enabling the player to accept or reject the award (input device 42 of Baerlocher et al. enable the player to accept an offer, wherein accepting the offer by the player constitutes acceptance of an award and input devices 44, 46 enable the player to reject the offer, wherein changing of the offer by the player constitutes rejection of an award). Also see col. 7, lines 7-18 of Webb, wherein a player may accept an award or reject the award for a secondary play and steps 106, 108 of Figure 3 of Baerlocher et al. along with the related description thereof.

### ***Conclusion***

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited (PTO-892). Specifically, Mangano et al. (U.S. Patent No. 6,059,658) teaches a plurality of concentrically arranged wheels having respective game symbols thereon upon which an award is provided to a player.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jason Skaarup whose telephone number is 571-272-4455. The Examiner can normally be reached on Monday-Thursday (10:00-8:00).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Primary, Jessica Harrison can be reached at 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JESSICA HARRISON  
PRIMARY EXAMINER